UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,793	01/31/2005	Robert James Eldridge	56-04	7006

23713 7590 07/12/2007

GREENLEE WINNER AND SULLIVAN P C
4875 PEARL EAST CIRCLE
SUITE 200
BOULDER, CO 80301

EXAMINER	
PEZZUTO, HELEN LEE	
ART UNIT	**PAPER NUMBER**
1713	

MAIL DATE	DELIVERY MODE
07/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,793	ELDRIDGE ET AL.	
	Examiner	Art Unit	
	Helen L. Pezzuto	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 19-37* is/are pending in the application.

4a) Of the above claim(s) *1 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-21 and 23-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1 and 19-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/8/05, 6/23/06, 1016/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 19-21 in the reply filed on 6/4/07 is acknowledged. The traversal is on the ground(s) that claims of Group II as amended, recites the same special technical feature as the claims of group I (i.e. the dispersing agent). Further, the references in the International search report do not anticipate this technical feature. Thus, restriction should be withdrawn. This is not found persuasive because the elected claims are found to lack novelty or an inventive step in view of US 6,171,489 and US 6,590,094 as set forth in this office.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/4/07.

Response to Amendment

Applicant's cancellation of claims 2-18, the amendment to claims 19-21, and the addition of claims 22-37 filed in the

response on 6/4/07 is acknowledged. Currently, claims 19-21, 23-37 is under consideration in this application.

Claim Objections

3. Claims 25-37 are objected to because of the following informalities: These dependent claims recite "The process according to…". They should recite "The complexing resin accordingly to…" so as to be consistent with the elected subject matter. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 19-21, and 23-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballard et al. (US-489).

US 6,171,489 to Ballard et al. disclose and exemplify polymer beads and method for their preparation. Prior art

polymer beads products are identical to those presently claimed and prepared by the identical dispersion polymerization process as used by applicant (see abstract; col. 7, lines 11-30; working Examples). Specifically, said dispersion contains a continuous aqueous phase, an organic dispersed phase containing a functional monomer and a crosslinking monomer, magnetic particles (i.e. γ-Fe_2O_3), solid dispersing agent is used in the formation of polymer beads (col. 2, lines 50-61; col. 3, lines 25-64; col. 5, lines 1-29). Suitable crosslinking monomer, functional monomers include the presently recited amine group-containing monomers and those which can be post-reacted to form the amine functionality (col. 4, lines 5-12) are disclosed. Furthermore, backbone monomer, porogen, and stabilizing agent were taught (col. 4, lines 16-45; col. 5, lines 22-29, 50-67). Accordingly, the instant invention is anticipated in view of prior art disclosure.

6. Claims 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Karlou-Eyrisch et al. (US-094).

US 6,590,094 to Karlou-Eyrisch et al. discloses crosslinked polymer beads doped with superparamagnetic iron oxide (see abstract, working examples). Prior art crosslinked polymer is derived from recurring units of

amino(meth)acrylates and amino(meth)acrylamide and a crosslinking comonomer (col.2, lines 1-67). Prior art further discloses and exemplifies oil-soluble copolymer dispersing aids within the scope of the instant dispersing agent (col. 4, lines 20-59; Working Examples 1 and 2). Thus, anticipating the present claims.

Claim Rejections - 35 USC § 102/103

7. Claims 21, 23-26, 31-33, and 36 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Karlou-Eyrisch et al. (US-094).

As discussed in the preceding paragraph, US 6,590,094 to Karlou-Eyrisch et al. discloses crosslinked polymer beads doped with superparamagnetic iron oxide, and a copolymer dispersing aid within the scope of the present product claims. Prior art teaches various functional and crosslinking comonomers within the scope of the present claims. The instant claim 21 is presented in a product-by-process format. Thus, it is well settled that the patentability of the claimed invention is determined based on the product itself, not on the method of making it. When applicant's product and that of prior art appear to be identical or substantially identical, the burden shifts to

applicant to provide evidence that the respective products do in fact differ and that the prior art product does not necessarily or inherently possess the characteristics and properties of applicant's claimed product.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 19-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, and 6 of U.S. Patent No. 6,171,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass those in US-489.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp